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PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Hirst, et al.

Serial No. 10/045,963

Filed: October 24, 2001

For: Cell Production

Art Unit: 1645

Examiner: Stephen Gucker

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Arlington, VA 22313-1450

Sir:

In response to the Election/Restriction requirement mailed on June 29, 2004, a response which is due July 29, 2004, without an extension of time, Applicants elect, with traverse, Group III directed to Claims 17-20, as the claims relate to partially or terminally differentiated neuronal cells.

Applicant makes the above election with traverse. Applicant submits that the invention is directed towards the partial or terminal differentiation of pluripotent cells towards neurectoderm cells, the regulation of the differentiation of neurectoderm cells into cells of the neural, glial and neural crest lineages, the cells produced therefrom, and their uses in human cell and gene therapy and the production of transgenic animals.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Arlington, VA 22313-1450 on July 29, 2004.

Elizabeth Cary Miller
Elizabeth Cary Miller - Reg. No. 54,708

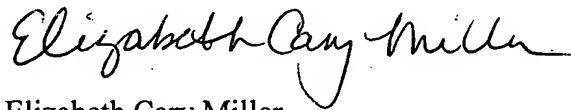
The Office Action has required that restriction under 35 U.S.C. §121 be made to one of seven claimed inventions. The Office Action states that a search and examination of all the methods of Inventions I-II and IV-VII would result in an undue burden on the Examiner, since the methods are separate and distinct, utilizing different starting materials, method steps, and require different outcomes. In addition, the Examiner states that while Inventions I-II and III are related as process of making and product made, the inventions are distinct because the partially or terminally differentiated neuronal cells of Invention III can be made by a method for producing differentiated or partially differentiated neurons of Invention I or they can be made by a method for producing dopaminergic neurons of Invention II.

Applicants respectfully submit that the restriction requirement does not meet the requirements set out in Chapter 800 of the MPEP, and accordingly requests that the Examiner review and withdraw the requirement. Section 803.01 of the MPEP states that there are two requirements for restriction between patentably distinct inventions: 1) the inventions must be independent or distinct as claimed and 2) there must be a serious burden on the examiner if restriction is required. Applicants submit that the Examiner has not demonstrated that it would be a serious burden to search and examine all of the claims together. Four of the seven groups of claims are within the same class and subclass, and therefore, are easily searched together. Two of the other groups are within the same class and subclass, and therefore, are also easily searched together. Four of the seven groups of claims are within the same class and subclass, and therefore, are easily searched together.

In summary, Applicants make the above election with traverse. Applicants submit that each of the restrictions is improper and respectfully requests that the Examiner review and withdraw each restriction requirement. The foregoing is submitted as a full and complete Response to the Office Action mailed June 29, 2004. No additional fees are believed due; however, the Commissioner is hereby authorized to charge any additional fees that may be required, or credit any overpayment to Deposit Account No. 19-5029.

The Examiner is invited and encouraged to contact the undersigned attorney of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully submitted,

A handwritten signature in cursive script, reading "Elizabeth Cary Miller".

Elizabeth Cary Miller
Reg. No. 54,708

Date: July 29, 2004

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SAB Docket: 18377-0006